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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

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KE, PENG	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY APPELMAN

Appeal 2010-001551
Application 09/848,231
Technology Center 2100

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Patent Examiner rejected claims 1-56. The Appellant appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The Appellant describes the invention at issue on appeal as "transferring electronic data between users of a communication system by delivering an e-mail [i.e., electronic mail] message from a sender to at least one recipient and indicating the online state of at least one of the sender and any other recipient of the e-mail message upon opening of the e-mail message by the recipient." (Abstract.)

ILLUSTRATIVE CLAIM

> 1. A communications method for transferring electronic data between users of a communications system, the method comprising:
>
> delivering an e-mail message from a sender to at least one recipient; and
>
> upon opening of the e-mail message by the recipient, indicating an online state of one or more of the sender and any one other recipient of the e-mail message.

REJECTIONS

Claims 1-4, 6-9, and 11-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. U.S. 2002/

0021307 A1 ("Glenn"); U.S. Patent No. 5,948,058 ("Kudoh"); and U.S. Patent No. 6,081,830 ("Schindler").

Claim 5 stands rejected under § 103(a) as being unpatentable over Glenn; Kudoh; Schindler; and U.S. Patent No. 6,525,747 B1 ("Bezos").

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Glenn; Kudoh; Schindler; and U.S. Patent No. 6,446,112 B1 ("Bunney").

CLAIMS 1-4, 6-9, AND 11-56

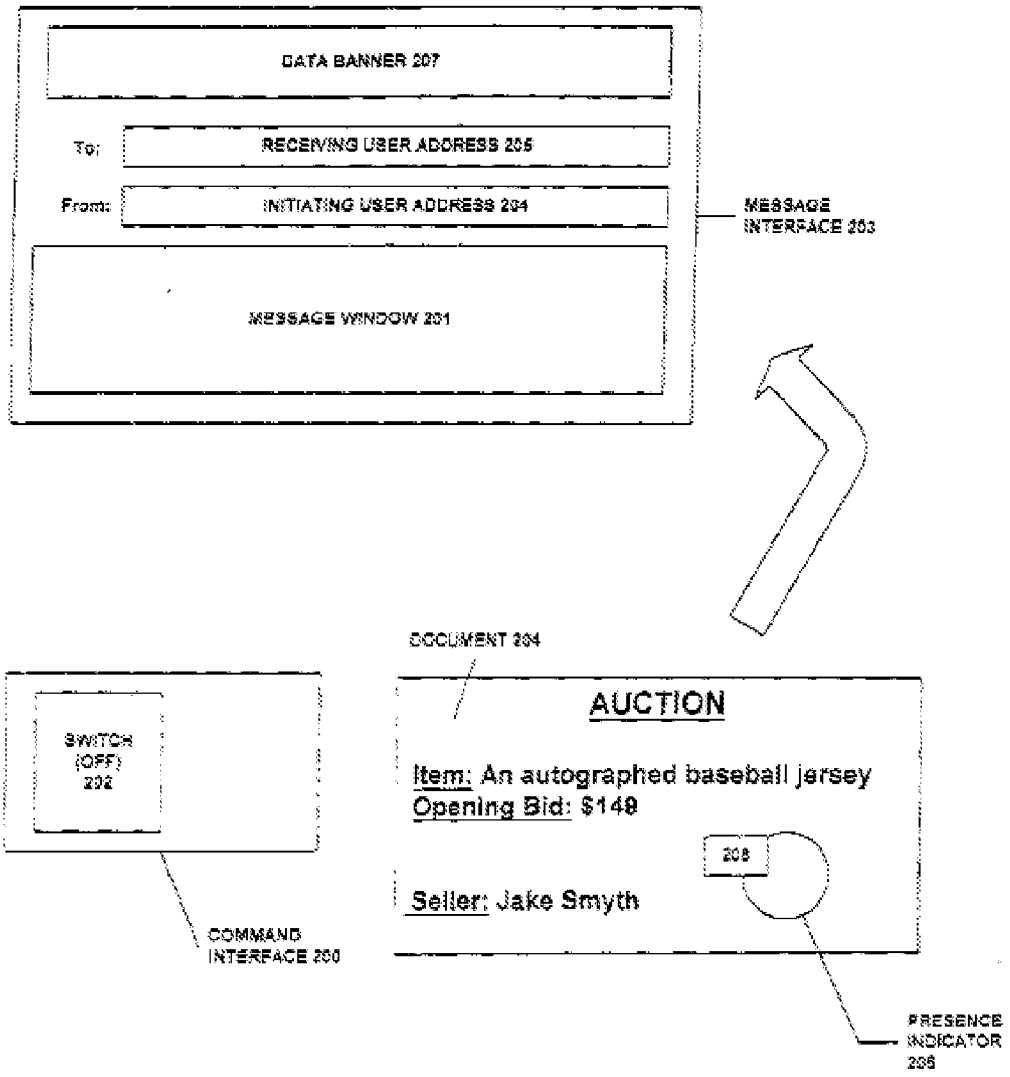
Based on the Appellant's arguments, we will decide the appeal of claims 1-4, 6-9, 11-51 on the basis of claim 1 alone and the appeal of claims 52-56 on the basis of claim 52 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii). The *issues* before us are (1) whether the Examiner erred in finding that the combined teachings of Glenn and Kudoh *inter alia* would have suggested delivering an e-mail message from a sender to at least one recipient and indicating an online state of the sender upon opening of the message by the recipient as required by representative claim 1, dependent claim 10, independent claim 26, and representative claim 52 and (2) whether the Examiner erred in finding that the combined teachings of Glenn and Kudoh *inter alia* would have suggested a user interface as also required by claim 26.

FINDINGS OF FACT

Glenn describes its invention as "an interconnection fabric (e.g. a network) configured to transmit data, a plurality of client devices that are each associated with a user, a presence indicator, a presence engine, a translation engine, a communication engine, and a broadcast engine." (Abstract, ll. 3-7.) "A presence indicator is a type of cue that may be embedded into a document and configured to provide users with a mechanism for determining when another user is connected to the interconnection fabric (e.g. a visual, audio, or video cue)." (*Id.* at ll. 7-11.)

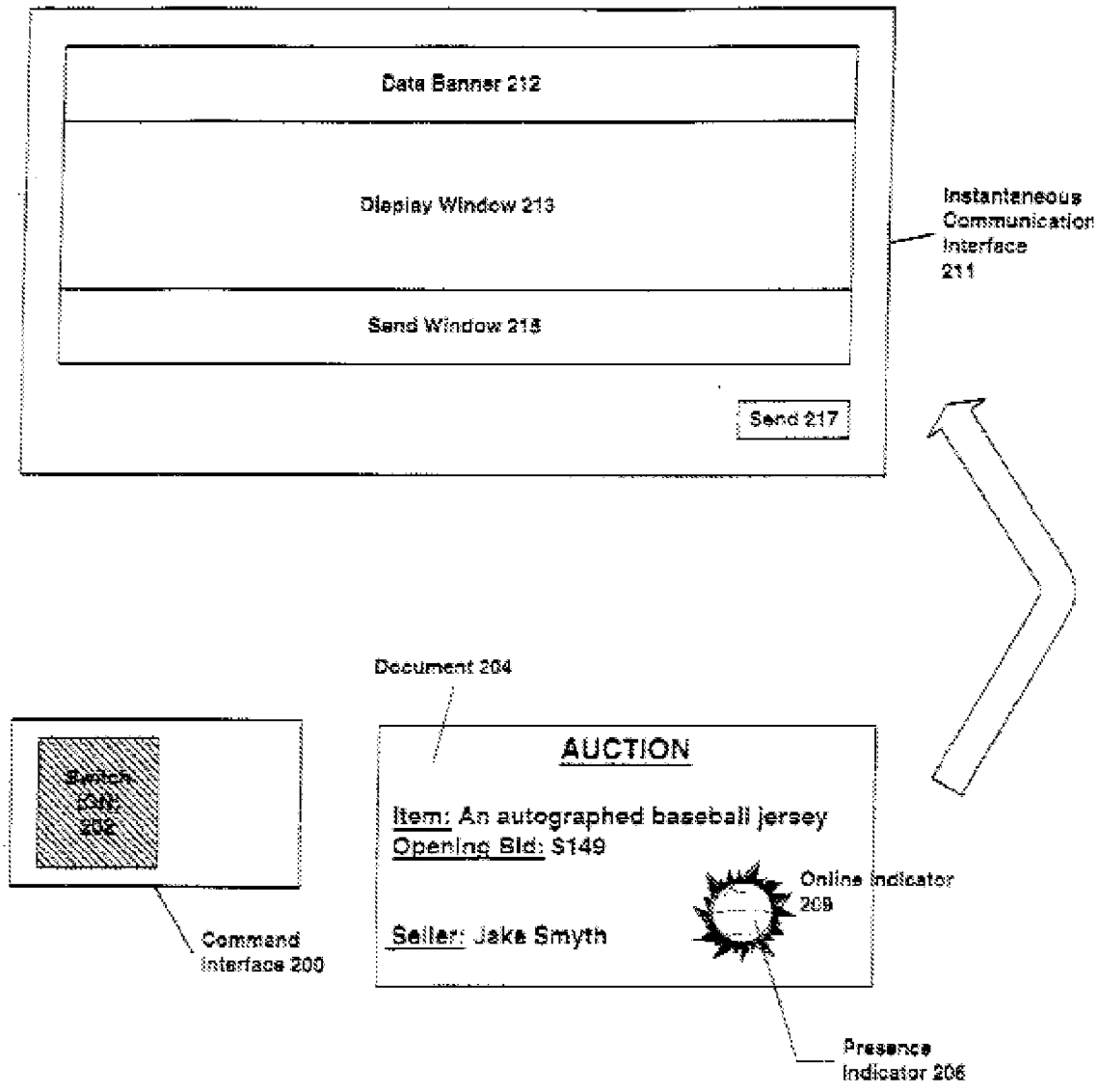
Figures 2 and 3 of Glenn follow:

Figure 2



"FIG. 2 comprises an illustration of several of the components of the invention in an offline state." (¶ [0031].)

Figure 3



"FIG. 3 comprises an illustration of several of the components of the invention in an online state." (¶ [0032].)

Kudoh describes its invention as "[a]n electronic mail cataloging and retrieving system . . . ." (Abstract, l. 1.)

ANALYSIS

We address the aforementioned issues *seriatim.*

Delivering an e-mail message and indicating an online state of its sender

The Examiner's interpretation that claims 1, 10, 26, and 52 "only require[ ] indication of the online state of either the sender or one other recipient" (Corrected Ans. 15) is uncontested. "Silence implies assent." *Harper & Row Publishers, Inc. v. Nation Enters.,* 471 U.S. 539, 572 (1985).

"The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art." *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *Keller*, 642 F.2d at 425). In determining obviousness, furthermore, a reference "must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." *Id.*

Here, the Examiner makes the following findings.

> [Glenn's] "receiving users" provide the information about their online statues, provide information about how they can be

> reached, and alternately provide the information about an ad regarding an autographed baseball jersey. (see Glenn; figure 2, items 204)[.] Therefore, one of these "receiving users" is the sender and the creator of this autographed baseball jersey ad, and any one, who is interested, would find out whether the seller is online upon opening the ad. (see Glenn; figure 2, item 204)[.]

(Corrected Ans. 15-16.) The Appellant argues that "the document (. . . 204) of Glenn is not described or suggested as being an electronic message between a sender and a recipient, particularly an e-mail message." (Appeal Br. 8.)

For its part, Glenn explains that the "[d]ocument 204 comprises any type of document that may be sent across an interconnection fabric . . . and displayed by a client program." (¶ 0056.) The Appellant further admits that "Glenn . . . discusses the use of e-mails" (Appeal Br. 9), and that "Kudoh teaches delivery of an e-mail from a sender to at least one recipient . . . ." (*Id.* at 8.)

Because Glenn intends its document to encompass any type of document that can be sent across an interconnection fabric for display by a client, and Glenn and Kudoh teach that an e-mail message is delivered from a sender to at least one recipient, we agree with the Examiner's finding that the combined teachings of Glenn and Kudoh *inter alia* would have suggested delivering an e-mail message from a sender to at least one recipient.

The Appellant also admits that Glenn's "document (see paragraphs 0056, 0060, 0061, 0063) . . . contains an embedded presence indicator." (Appeal Br. 8.) Figures 2 and 3 of the same reference, *supra*, exemplify document 204 as an ad for the auction of an autographed baseball jersey, with an embedded presence indicator 206 that indicates whether the seller is offline 208 or online 209. We agree with the Examiner's aforementioned finding that when one of Glenn's users sends the ad to a recipient in the form of an e-mail message, the recipient would learn whether the seller is online upon opening the ad.

Based on the aforementioned teachings of the references, we are unpersuaded by the Appellant's other arguments that "the Office's suggested modification of the Glenn reference . . . include[s] features that were intentionally avoided by Glenn" (Appeal Br. 9) and amount to "an improper hindsight reconstruction of the claimed subject matter" (*id.*), and that "it is unreasonable to suggest that Glenn describes indicating the online state of the sender . . . ." (*Id.* at 13.)

Therefore, we *conclude* that the Examiner did not err in finding that the combined teachings of Glenn and Kudoh *inter alia* would have suggested delivering an e-mail message from a sender to at least one recipient and indicating an online state of the sender upon opening of the message by the recipient as required by representative claim 1, dependent claim 10, independent claim 26, and representative claim 52.

User interface

The Appellant also argues that the "on-line auction document of Glenn (see FIG. 2 and 3 of Glenn) does not contain a user interface for viewing e-mail messages and means for indicating an online state of at least one of the sender . . . ." (Appeal Br. 12.) As explained regarding the prior issue, *supra*, the combined teachings of Glenn and Kudoh *inter alia* would have suggested delivering a document as an e-mail message from a sender to at least one recipient, wherein the message indicating an online state of the sender upon opening thereof by the recipient.

Glenn further explains that, once open, the document permits the recipient to communicate with the sender. More specifically, when the sender is offline, and the recipient clicks on the offline indication 208, the document "opens a window message interface 203 that provides a location for entering an electronic mail message (e.g. message window 201)." (¶ 0056, ll. 19-21.) When the sender is online, "[s]electing presence indicator 206 . . . executes an instantaneous communication interface 211"(¶ 0059, ll. 8-10.), i.e., "an executable computer program configured to transmit data entered into send window 215 directly to the client computer at which the [sender] resides." (*Id.* at ll. 10-13.)

Because the document provides information to a recipient about the state of the sender and allows the recipient to send a message to the sender, we agree with the Examiner that it constitutes a user interface. Therefore, we *conclude* that the Examiner did not err in finding that the combined

teachings of Glenn and Kudoh *inter alia* would have suggested a user interface as required by claim 26.

CLAIMS 5 AND 7

The *issues* before us are (1) whether the Examiner erred in finding that Bezos teaches an invitation to join a communication system as required by claim 5 and (2) whether the Examiner erred in finding that Glenn teaches an icon positioned next to an e-mail address in the e-mail message as required by claim 7.

FINDINGS OF FACT

Bezos describes its invention as "[a] method and system for conducting an electronic discussion relating to a topic." (Abstract, ll. 1-2.)

ANALYSIS

We address the aforementioned issues *seriatim.*

Invitation to join a communication system

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently . . . ." *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citations omitted).

Here, the Examiner admits that the combined teachings of Glenn, Kudoh, and Schindler "do not teach . . . [that] the e-mail message comprises an invitation to join the communications system." (Corrected Ans. 13.) He finds that "Bezos teaches wherein an e-mail message comprises an invitation to join the communications system (see Bezos, column 7, lines 5 - 31)." (*Id.* at 13-14.)

We agree with the Appellant, however, "that combining Bezos with the modified method of Glenn, Kudoh and Schindler would not result in any system or method . . . wherein the e-mail message includes an invitation to join the communication system." (Appeal Br. 11-12.) More specifically, part of Bezos cited by the Examiner teaches that an "email body 505 indicates that a certain user has requested to join the discussion and asks the originating participant whether this user may join the discussion." (Col. 7, ll. 15-19.) In other words, this part of Bezos teaches a request to join a discussion rather than an invitation to join a communication system. Therefore, we *conclude* that the Examiner erred in finding that Bezos teaches an invitation to join a communication system as required by claim 5.

Icon positioned next to an e-mail address

The Examiner finds that "Glenn further teaches . . . an icon positioned next to an e-mail address in the e-mail message (see Glenn, figure 3, items 206 and 209)[.]" (Corrected Ans. 6.)

We agree with the Appellant, however, "that Glenn cannot reasonably stand for the teaching that a graphical user interface comprises an icon positioned next to an e-mail address . . . ." (App. Br. 10.) As aforementioned, Figures 2 and 3 of Glenn show document 204 as an ad for an auction. The ad includes an identification of the jersey for auction, viz., an autographed baseball jersey; an opening bid for therefor, the seller of the jersey, and the embedded presence indicator 206.

None of these items constitutes an e-mail address. The Examiner does not allege, let alone show, that the addition of Kudoh or Schindler cures the aforementioned deficiency of Glenn. Therefore, we *conclude* that the Examiner erred in finding that Glenn teaches an icon positioned next to an e-mail address in the e-mail message as required by claim 7.

DECISION

We affirm the rejections of claims 1, 10, 26, and 52 and that of claims 2-4, 6-9, 11-51, which fall with claim 1, and that of claims 53-56, which fall with claim 52. In contrast, we reverse the rejections of claims 5 and 7.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED-IN-PART

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413